

REMARKS

Applicant respectfully requests reconsideration and allowance of claims 1-20 that are pending in the above-identified patent application. Applicant has amended claims 1 and 18, and the specification. No new matter is added by these amendments.

Claim Rejections Under 35 U.S.C. § 103(a)

U.S. 5,152,284

At pages 2-5 of the Office Action, the Examiner rejected claims 1-10 and 17-20 under 35 U.S.C. § 103(a) as being obvious over U.S. 5,152,284 ("the '284 patent" or "Valentini"). Applicant respectfully traverses the Examiner's rejection.

Independent claims 1 and 17 require that "the features forming the outer contour of the capsule are symmetrical with respect to a transverse plane which bisects the longitudinal axis," excluding seams, elements smaller than 0.1 mm, and/or angles of taper up to 5°. The claimed process and structure regarding symmetry results in identical inflow and vibration conditions irrespective of the direction of insertion of the capsule into the inhaler.

The '284 patent fails to disclose or suggest the above-quoted limitations of independent claims 1 and 17. The Examiner alleges that the capsule of Valentini is symmetrical with respect to a transverse plane which bisects the longitudinal axis – as claimed. This allegation, however, is incorrect on two grounds: first, the capsule contains pre-cut holes 42, 44 on one capsule part but not on the other part; and second, each capsule part is a different size, resulting in the discontinuity near the middle of the capsule body. The Examiner's allegation that the capsule elevation (the discontinuity) in Valentini is a taper up to 5° as claimed is erroneous. The elevation of Valentini is substantially perpendicular (at an angle close to 90°) – and, thus, is not is not a taper up to 5°. The instant application differentiates between "tapers" and "elevations", e.g., see claims 4 and 5. This difference, in tandem with the aforementioned symmetry requirements in claims 1 and 17, clearly distinguish over Valentini. Indeed, Valentini teaches away from a capsule with a symmetrical outer

contour as claimed. The Examiner concedes, at page 3 of the Office Action, that Valentini lacks a detailed description of the claimed steps; however, the Examiner makes the erroneous conclusion that Valentini discloses the claimed structure. As the claimed symmetry is lacking in the device of Valentini, it discloses neither the claimed steps (of claim 1) nor the claimed structure (of claim 17).

As the subject dependent claims include the limitations of the base claim(s), they are likewise patentable. Accordingly, Applicant respectfully requests that the § 103 rejection of the subject claims be withdrawn.

U.S. 5,947,118

At pages 6-8 of the Office Action, the Examiner rejected claims 11-16 under 35 U.S.C. § 103(a) as being obvious over U.S. 5,947,118 ("the '118 patent" or "Hochrainer"). Applicant respectfully traverses the Examiner's rejection.

Independent claims 1 and 16 require that "the features forming the outer contour of the capsule are symmetrical with respect to a transverse plane which bisects the longitudinal axis," excluding seams, elements smaller than 0.1 mm, and/or angles of taper up to 5°. As discussed above, the claimed process and structure regarding symmetry results in identical inflow and vibration conditions irrespective of the direction of insertion of the capsule into the inhaler.

Hochrainer fails to disclose or suggest the above-quoted limitations of independent claims 1 and 16. Although the Examiner alleges that the capsule of Hochrainer is symmetrical with respect to a transverse plane which bisects the longitudinal axis – as claimed --, such allegation is incorrect. The capsule chamber in Hochrainer discloses ribs that hold the capsule in place and deform the capsule (col. 2, lines 19-21; and FIG. 4). As such, the capsule chamber in Hochrainer does not disclose the symmetry feature of independent claims 1 and 16. Indeed, Hochrainer teaches away from a capsule with a symmetrical outer contour as claimed. The Examiner concedes, at page 8 of the Office Action, that Hochrainer lacks a detailed description of the claimed steps; however, the Examiner makes the erroneous conclusion that Hochrainer discloses the claimed symmetry structure. As the claimed symmetry is lacking in the device of Hochrainer, it discloses neither the claimed steps (of claim 1) nor the claimed structure (of claim 16).

As the subject dependent claims include the limitations of the base claim(s), they are likewise

patentable. Accordingly, Applicant respectfully requests that the § 103 rejection of the subject claims be withdrawn.

Objection to the Drawing

At pages 8-9 of the Office Action, the Examiner objected to the drawing alleging that the specification refers to label 18 as the channel and the button. In response, Applicant has amended the specification to recite that reference label 18 is the channel and reference label 8 is the button. In view of the above, Applicant respectfully requests withdrawal of the drawing objection.

Objections to the Specification

At page 9 of the Office Action, the Examiner objected to specification as to an informality. In this regard, Applicant assumes that the Examiner has not objected to the specification as not discussing the subject matter shown in FIG. 3d – indeed, FIGS. 3a – 3d are discussed in detail at page 19, line 26 through page 21, line 25. In response, Applicant has amended the specification at page 18 to more clearly set forth the "brief description" of FIG. 3d. Accordingly, Applicant respectfully requests that the objection to the specification be withdrawn.

Objections to the Claims

At page 9 of the Office Action, the Examiner objected to claims 1 and 18 as to antecedent bases. In response, Applicant has amended the subject claims to ensure antecedent bases for the term "seam" exist. Accordingly, Applicant respectfully requests that the objections to claims 1 and 18 be withdrawn.

Conclusion

In view of the foregoing, Applicant submits that the instant claims are in condition for allowance. Early and favorable action is earnestly solicited. In the event there are any fees due and owing in connection with this matter, please charge same to our Deposit Account No. 11-0223.

Dated: July 16, 2007

Respectfully submitted,

By s/Matthew B. Dernier/
Matthew B. Dernier
Registration No.: 40,989
KAPLAN GILMAN GIBSON & DERNIER LLP
900 Route 9 North, Suite 104
Woodbridge, New Jersey 07095
(732) 634-7634
Attorneys for Applicant

G:\Clients\Boehringer Ingelheim-MBD-539\539-33 (1-1449)\539-33_1-1449_Response-to-OA_mailed-04-17-2007.doc